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| 44305               | 7590        | 10/30/2008           | EXAMINER                      |                  |
| WITHERS & KEYS, LLC |             |                      |                               |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/715,303

**Applicant(s)**

WILKERSON ET AL.

**Examiner**

JAMISUE A. PLUCINSKI

**Art Unit**

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE-US)  
Paper No(s)/Mail Date 20040330
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Claims 1-16 in the reply filed on 7/15/08 is acknowledged. The traversal is on the ground(s) that it is not a serious burden to the examiner to search both concepts. This is not found persuasive because the examiner has not made a restriction and has not stated that they are independent and distinct inventions, but rather made an election requirement, stating that there is two independent and distinct species. In the two sets of claims, in which the specification states is one aspect and another aspect of the invention, the applicant has wrote the claims so that one set of claims is directed to one embodiments, where the value plan is written for a specific target customer, and the other value plan is written for a segment of customers, and each customer is put into a separate groups. These are two distinct embodiments of the invention. If one of the embodiments is deemed to be allowable, and the withdrawn embodiment has the allowable feature(s), then the embodiment will be rejoined at that time. For examination purposes, the two sets of claims are going in two different directions, therefore the examiner considers the election to be proper.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The applicant has claimed the limitation "quantifying a value of each improved experience", without giving any guidance in the specification as to how this is done. There is no equation or algorithm in the specification which supports this limitation. The specification does talk about assigning a worth to a customer experience, however never states that this experience is the improved experience. Furthermore, if this were an improved experience, the applicant has never described the metes and bounds of the number, but rather states it can be representative of any scale set by a user. It is unclear what exactly the rating is, is it representative of how much money the customer spends to receive the experience, or how much money is saved using the improved experience, or how much revenue is generated? It can be a multitude of different things and can be represent anything the user wants it to. Therefore subjective to who uses the system/software/method. Furthermore in Claim 2 the applicant claims assigning a relative performance value and a relative importance value. These steps appears to be in the "developing a value proposition" step and appear to be separate from the "quantifying" step. Therefor, the specification disclosing assigning a worth, it is unclear if this is the steps of "quantifying a value of each improved experience", "assigning a relative performance value" or "assigning a relative importance value".

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. With respect to Claim 1: the phrase “quantifying a value of each improved experiences” is indefinite. It is unclear to the examiner what “value” this is representative of. The claim recites that it can be any value of the experience, therefore does not particularly point out and distinctly claim what the value should be.
7. Claim 7 recites the limitation “the target client” in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The first step in determining whether a claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 USC 101: process, machine, manufacture and composition of matter. The latter three categories define “things” or “products”, while a “process” consists of a series of steps or acts to be performed. For purposes of 101, a “process” has been given a specialized, limited meaning by the courts.

Based on Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 US 584, 588 n.9 (1978); and *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)), a 101 process must 1) be tied to another statutory class (such as a particular apparatus) or 2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under 35 U.S.C. 101.

**Claims 1-16** are drawn to a computerized method for enabling a client to identify a target customer and develop delivery strategies. However all of the recited method steps can be performed in the mind of the user and therefore the method steps are not tied to another statutory class, and does not transform the underlying subject matter. The applicant has stated that the method is computerized, however this is a nominal recitation of technology which is found only in the preamble, and therefore the body of the claims is not considered to be tied to another statutory class because they do not positively recite the computer performing these steps.

An invention, which is eligible for patenting under 35 U.S.C. § 101, is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a “useful, concrete and tangible result.” The test for practical application as applied by the examiner involves the determination of the following factors:

- (a) “Useful” - The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the

claimed invention to determine whether the asserted utility is accomplished.

Applying utility case law the examiner will note that:

i. the utility need not be expressly recited in the claims, rather it may be inferred.

ii. If the utility is not asserted in the written description, then it must be well established.

- (b) "Tangible" - Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. § 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.
- (c) "Concrete" - Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

**Claims 1-16** are rejected under 35 U.S.C. 101 because the claimed invention lacks tangibility and concreteness. Specifically:

In Claims 1-16, the ambiguities cited would make it impossible for the process to be repeatable or “concrete.” In other words, different users would come up with different responses.

As per Claims 1-16, the method claims quantifying a value of each improved experience. As stated above in the 112 1st paragraph rejection. The specification discloses a assigning a worth to a customer experience, however never states if this is the improved experience, and never discloses what this value actually is. The only guidance in the specification states that the scale can represent any scale which is set by a user. And therefore never even discloses what exactly is being quantified. Therefore quantifying the value lends itself to be set by the user and therefore considered to be subjective and hence not concrete or tangible.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1, 2, 4-8 and 10-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Farnes et al. (US 2003/0163365).



11. With respect to Claim 1: Farnes discloses the use of a computerized method for enabling a client to identify a target customer and develop value strategies for obtaining business from the target customer (see abstract) comprising:

- a. Defining a value delivery network of the client, the value delivery network including the target customer (see abstract and Figure 2A);
- b. Defining a team from the client to visit the target customer (Paragraphs 0020, 0028, 0036 and 0079);
- c. During the visit with the target customer, documenting current events of relevance to the target customer and perfect events idealized by the target customer (Paragraphs 0037 and 0047, and Reference numerals A.3.1 and A.5 with corresponding detailed explanations);
- d. Developing preferred events based on the current events and the perfect events documented during the visit (Reference numeral B.3. with corresponding detailed description and Paragraph 0037);
- e. Identifying improved experiences available to the target customer based on the preferred events (B.4. with corresponding detailed description);
- f. Quantifying a value of each improved experiences to the target customer (Paragraphs 0052, 0057 and 0070);
- g. Developing a value proposition for the target customer based on the improved experiences identified (See Reference numeral A.6. with corresponding detailed description); and

- h. Developing a value delivery strategy for implementing the value proposition (Reference numeral B.7. with corresponding detailed description).
- 12. With respect to Claim 2: Farnes discloses the use of documenting current events with both the client and the competitors of the client and assigning performance and improvement value to the improved experiences (Paragraphs 0050 and 0057 and Claim 16).
- 13. With respect to Claim 4: Farnes discloses the collection of data which can be by a customer visit is defined by a work plan and where the work plan is permitted to be modified on an on-going basis (See Paragraph 0106). It should be noted that the term “permitted to” when given the broadest reasonable interpretation is very broad, and as long as the reference does not prevent it from happening, then it permits it to happen.
- 14. With respect to Claim 5: Farnes discloses the use of surveys used for the target customer (Paragraph 0071).
- 15. With respect to Claim 6: See Farnes, Paragraphs 0015, 0034, and 0038.
- 16. With respect to Claim 7: Farnes discloses the use of identifying improvement opportunities for the client (Paragraphs 0065, 0066 and 0094).
- 17. With respect to Claim 8: Farnes discloses the use of assigning a worth to the customer and consequences of the improved experience is identified (See Reference numeral C.7. and Paragraphs 0065-0066).
- 18. With respect to Claims 10 and 12: Farnes discloses a step of developing a value delivery strategy for how the experiences will happen and how they will be communicated to the customer and client, content and mode of delivery (See Paragraph 0067).

19. With respect to Claim 11: Farnes discloses identifying required actions by all parties involved (See solution matrix, Paragraph 0088).
20. With respect to Claim 13: See Farnes 0106.
21. With respect to Claim 14: Farnes discloses the use of a milestone plan, which the examiner considers to be identifying required actions over a chosen timeline (See Paragraphs 0100 and 0102)

***Claim Rejections - 35 USC § 103***

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
24. Claims 3, 9, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farnes et al. (US 2003/0163365).

25. With respect to Claim 3: Farnes discloses the use of a value proposition which includes a time horizon, and improved experiences (see paragraph 0060). And fails to disclose the value proposition including a price that will be charged. However, the specific type of information which is contained in the value proposition is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The developing steps would be performed the same regardless of what type of information is in the value proposition. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

26. With respect to Claim 9: Farnes discloses collecting current experiences of the best competitors, however fails to disclose identifying a best alternative most likely to provide the improved experience, and where the best alternative being a competitor. The examiner takes official notice that identifying the best alternative competitor to a customer is old and well known in the art. This has been done by Progressive auto insurance, they give you their rates as well as the rates of their competitors, in order to show the customer what other rates would be without having the customer shop around to other insurance companies. Therefore it would have been obvious to one of ordinary skill in the art to modify Farnes to also show the customer the best alternative of the competitor, in order to ensure that the customer is getting what they want, and to make sure the customer is informed of their options.

27. With respect to Claim 15 and 16: Farnes discloses that actions are assigned to specific functional areas within a client (Paragraphs 0103-0107) and discloses the use of storage devices used in the method (Paragraphs 0017 and 0102) however fails to specifically disclose the plans being stored in a database. The examiner takes official notice that it is old and well known in the art the feature of storing information which needs to be utilized at a later time, in a database. The value proposition plan of Farnes is being tracked and is constantly being evaluated, therefore it would need to be stored in order to access at a later time. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to store the value propositions plans and all they entail, in a database, for convenient retrieval of information.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/  
Primary Examiner, Art Unit 3629